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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/023,456

10/30/2001

Jose Costa Requena

944-001.038-1

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12/27/2005

Ware, Fressola, Van Der Sluys & Adolphson, LLP
Building Five, Bradford Green
755 Main Street
P.O. Box 224
Monroe, CT 06468

EXAMINER

SIDDIQI, MOHAMMAD A

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|--|--|
| Office Action Summary | Application No. 10/023,456 | Applicant(s) REQUENA, JOSE COSTA | |
| | Examiner Mohammad A. Siddiqi | Art Unit 2154 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 17-21 are presented for examination. Claims 1-16 and 22-25 have been cancelled.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 17, 18, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Dalal et al. (US 2002/0065894) (hereinafter Dalal).

3. As per claim 17, Dalal discloses, System, comprising:
a central server (instant messaging server, page 2, paragraph #0014), responsive to an invitation message from an inviting user to exchange content with an invited user, for providing a presence query (user can initiate instant messaging session, page 1, paragraph #0006); and
a presence server, responsive to said presence query, for providing presence information relating to a registered user (presence server display's the user's presence data, page 2, paragraph #0014),

wherein said central server is responsive to said presence information relating to said invited user registered at said presence server (presence server, page 2, paragraph #0016), for use in deciding said content is sent to said invited user, stored or refused (presence server, page 2, paragraph #0016), wherein said presence query and invitation message are communicated according to an application layer control protocol (using protocol, Page 2, paragraph #0016) and wherein said information relating to presence pertains to a spatial location of said registered user (John is online, Page 2, paragraph #0016).

4. As per claim 18, Dalal Discloses central server is also responsive to said invitation message for providing a subscription query and wherein said system further comprises a messaging server (instant messaging server, page 2, paragraph #0014), responsive to said subscription query, for providing notification information relating to a request from a subscribed user for notification of an event (user can be notified, page 1, paragraph #0009), and wherein said central server is responsive to said notification information for said subscribed user in deciding said content should be sent to said invited user, stored or refused (user preference, subscriber is a user who subscribes Instant messaging, page 2, paragraph #0017).

5. As per claim 21, Dalal disclose information relating to presence and pertaining to said spatial location of said user is communicated as a spatial location payload (John is online, Page 2, paragraph #0016).

Claim Rejections - 35 USC § 103

6. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalal et al. (US 2002/0065894) (hereinafter Dalal) in view of "Official Notice".

7. As per claim 19, examiner takes "official notice" on the concept and use of application layer control protocol is a session initiation protocol (SIP). Because The Session Initiation Protocol (SIP) is an Internet Engineering Task Force standard protocol for initiating an interactive user session that involves multimedia content such as video, voice, chat, gaming, and virtual reality, like HTTP or SMTP, SIP works in the Application layer of the Open Systems Interconnection communications model, the Application layer is the level responsible for ensuring that communication is possible. SIP can establish multimedia sessions or Internet telephony calls, and modify, or terminate them, the protocol can also invite participants to instant messaging sessions that do not necessarily involve the initiator, because the SIP supports name

mapping and redirection services, it makes it possible for users to initiate and receive communications and services from any location, and for networks to identify the users where ever they are. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use SIP protocol with teachings of Dalal. The motivation would have been using industry standard Session Initiation Protocol (SIP).

8. As per claim 20, the claim is rejected for the same reasons as claim 19, above, in addition, Dalal disclose information relating to presence and pertaining to said spatial location of said user is communicated as a spatial location payload (John is online, Page 2, paragraph #0016).

Response to Arguments

9. Applicant's arguments filed 09/26/2005 have been fully considered but they are not persuasive, therefore rejections to claims 17-21 is maintained.

10. In the remarks applicants argued that:

Argument: The provisional application (60/168,881 filed on December 3, 1999) is quite different from the regular application (filed on November 30, 2000).

Response: If the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application. See MPEP 706.02. The conceptual description or design of providing user-controlled presence information in the instant messaging environment to other users is well explained in Dalal's provisional application (60/168,881 filed on December 3, 1999) APPENDIX A sections 1-6. Thus conceptually contents of the provisional application fully supports the rejection based on the regular application. It is noted that that provisional application is lacking fig 2. However, one of ordinary skill in the art would understand that fig 2 of regular application revolves around many related concepts and models described in provisional application.

Dalal discloses, a central server (21, fig 1, instant messaging server, page 2, paragraph #0014, introduction in provisional application), responsive to an invitation message from an inviting user to exchange content with an invited user, for providing a presence query (user can initiate instant messaging session, page 1, paragraph #0006, section 2 of

provisional application); and a presence server (15, fig 1, section 2, provisional Application), responsive to said presence query, for providing presence information relating to a registered user (presence server display's the user's presence data, page 2, paragraph #0014), wherein said central server is responsive to said presence information relating to said invited user registered at said presence server (presence server, page 2, paragraph #0016), for use in deciding said content is sent to said invited user, stored or refused (presence server, page 2, paragraph #0016, section 3 of provisional application), wherein said presence query and invitation message are communicated according to an application layer control protocol (using protocol, Page 2, paragraph #0016) and wherein said information relating to presence pertains to a spatial location (section 1-3 of provisional application) of said registered user (John is online, Page 2, paragraph #0016, section 2 and 3 of provisional application).

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Dalal teaches instant messaging communication system where user can track presence of other user. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use SIP protocol with the teachings of Dalal. The motivation would have been using industry standard Session Initiation Protocol (SIP) because, the Session Initiation Protocol, is a signaling protocol for Internet conferencing, telephony, presence, events notification and instant messaging.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAS


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100